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REPLY BRIEF

Applicant	:	Jonathan Leblang
App. No	:	10/748,745
Filed	:	December 30, 2003
For	:	COMPUTER CONTROLLED ARTICLE CLASSIFICATION AND PROCESSING SYSTEM
Examiner	:	Tonya S. Joseph
Art Unit	:	3628
Conf. No.	:	2677

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Sir:

This Reply Brief is responsive to the Examiner's Answer issued on September 3, 2009 (the "Answer"). The arguments and responses in this Reply Brief supplement those presented in the Appeal Brief filed on July 14, 2009 (the "Appeal Brief").

As a preliminary matter, the "grounds of rejection" section extending from page 3 to page 8 of the Examiner's Answer appears to be substantially identical to the grounds for rejection set forth in the Final Office Action. Because the Appeal Brief already fully addresses the issues raised in this "grounds of rejection" section, this Reply Brief only responds to the issues raised in the "response to argument" section beginning at page 8.

For clarity, the Reply Brief utilizes the name section numbering as the Examiner's Answer.

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A. Introduction

The Introduction of the Examiner's Answer points to various portions of Knorr (U.S. Patent Publication No. 2002/0077929) as disclosing a system for processing electronically pending order items purchased from on-line catalogs, where a purchaser is able to purchase items in advance of a specifically requested delivery date, the order is pended in a database until the final order execution corresponding to a specific delivery date as indicated by the purchaser. As this aspect of Knorr is not in dispute, Appellant will not address these portions of the reference.

B.

In the Appeal Brief, Appellant argued that the rejection of Claim 1 is improper at least because Knorr does not disclose, explicitly or inherently, "a second module that, based at least in part on information retrieved from the database, *identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order*; and a third module that causes *a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment.*

Similarly, with respect to Claim 50, Appellant argued that the rejection of Claim 50 is improper at least because Knorr does not disclose, explicitly or inherently, the method of *identifying a first article that can be added to the pending order without delaying the shipment date of the pending order based at least in part on information retrieved from a database that stores article identification information and article location information for a plurality of articles* or *providing a notification for the user that indicates that the user can add the first article to the pending order without delaying the pending order shipment date.*

In responding to the foregoing arguments, the Examiner's Answer relies on paragraphs 20, 45, 50, 51, 61-62 of Knorr. (Examiner's Answer, Section B, at pages 9-12). The referenced disclosure of Knorr, however, does not overcome the deficiencies identified in the Appeal Brief.

Knorr does describe, with reference to the order pending processes of Figures 9A-C, that "the vendor can use the time between the electronic hold and the ultimate order execution to plan inventory and interact with the purchaser for suggestive sellings, i.e., up-selling and or cross-selling." (Knorr ¶ 65) Knorr also discloses with respect to the embodiment illustrated in

Figures 9A-C that the "order pending shopping cart may also be cancelled or modified anytime during the monitoring mode … the order pending database holds the information for the order pending shopping cart for that event." (Knorr ¶ 65).

With reference to another embodiment of the order pending process, illustrated in Fig. 3, Knorr states that the illustrated order pending process is directed to "a scenario related to a purchaser buying an item for a specific special occasion" (Mother's Day) (Knorr ¶ 50). Knorr states that the:

"purchaser may be notified of situations in which the pended order item may not be available. The purchaser may be presented with options for alternate products they may wish to substitute. A vendor may wish to offer a discount in connection with this alternate or 'second choice' suggestion. Alternately, a vendor may, in the case of product unavailability, have the order filled by a third party or alternate supplier, in a manner that is transparent to the purchaser and recipient, in order to maintain customer loyalty. The vendor may, for example, notify the order pending database administrator of the product unavailability, and either present an alternate or substitute product, or request help in having the order filled through another fulfillment entity, preferably transparently" (Knorr ¶ 50).

Further, with respect to the "special occasion" process illustrated in Figure 3, Knorr discloses that "the recipient receives the items no later than the requested delivery date, which in this case is the occasion date, e.g. Mother's Day". (Knorr ¶ 51).

The Examiner's Answer alleges that:

"One can clearly add to the order without effecting the previously set delivery date. If an item is unable to be fulfilled in time for a scheduled delivery date, the system of Knorr provides a notification and suggests alternatives".

However, the Examiner's Answer appears to be selectively picking aspects of different embodiments disclosed by Knorr and combining them to create an embodiment not expressly or inherently disclosed by Knorr. As discussed above, Knorr discloses a variety of processes for different scenarios. Figure 3 and the corresponding description at paragraphs 50-51 relied upon by the Examiner's Answer are specifically directed to "a scenario related to a purchaser buying an item for a specific special occasion," (Knorr ¶ 50), where it is important that the item be delivered in time for the occasion (Mother's Day). In this particular scenario, the only suggestions made to the purchaser are for an alternate to, or upgrade from a requested product. However, for this scenario (directed to a purchaser buying a product for a recipient where it is important that the gift be delivered to the recipient in time for the special occasion), significantly

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no mention is made of suggesting to the purchaser that another item be added to the purchaser's order in addition to the requested item. This of course is logical, as the timing of the product delivery is important in such a scenario, and Knorr fails to disclose any process for identifying articles that could be added to a pending order without delaying shipment of the pending order.

Still further, while the description regarding the embodiment of Figure 3 mentions that "the recipient receives the items no later than the requested delivery date," Knorr fails to disclose or discuss not delaying a *shipment date*. Nor is it inherent in the disclosure of Knorr that the shipment date is not delayed. For example, it is of course possible for a shipment date to be delayed while still allowing the item to be received no later than the requested delivery date. By way of illustration, if an item is ordered three months before a requested delivery date, even if the shipment is delayed several weeks, the shipment may still arrive no later than the requested delivery date. Thus, the citations relied upon by the Examiner's Answer fail to explicitly or inherently disclose the feature of "a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order" as recited by Claim 1 or "identifying a first article that can be added to the pending order without delaying the shipment date of the pending order based at least in part on information retrieved from a database that stores article identification information and article location information for a plurality of articles" as recited by Claim 50.

Further, unlike the process illustrated in Figure 3, the embodiment illustrated in Figures 9A-9C and described at paragraphs 61-70 is not concerned with a scenario where a purchaser is buying an item for a specific special occasion. Neither Figures 9A-C nor the corresponding description make mention of any special occasion or that the recipient receives the items no later than a requested delivery date, much less any mention of not delaying a shipping date. In the scenario of paragraphs 61-70, where an item does not have to be delivered in time for a special occasion, Knorr discloses that the vendor can use the time between the electronic hold and the ultimate order execution to cross-sell. However, Knorr fails to disclose that such a cross-sell would not delay the shipment date or even the delivery date. Indeed, nowhere does Knorr disclose that an item may be added to a pending order without delaying a shipping date.

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Thus, the foregoing citation to of paragraphs 61-70 of Knorr also fails to explicitly or inherently disclose an embodiment that includes "a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order," as recited by Claim 1 or "identifying a first article that can be added to the pending order without delaying the shipment date of the pending order based at least in part on information retrieved from a database that stores article identification information and article location information for a plurality of articles" as recited by Claim 50.

Further, with respect to Claim 50, the Examiner's Answer does not fully address the recitation "identifying a first article that can be added to the pending order without delaying the shipment date of the pending order based at least in part on information retrieved from a database that stores article identification information and *article location information* for a plurality of articles." This failure to consider all of the elements of Claim 50 is improper. *See* M.P.E.P. § 2143.03 ("All words in a claim must be considered in judging the patentability of that claim against the prior art").

In addition, as noted in the Examiner's Answer, Knorr mentions various reminder and notification periods or dates, including a last chance to change or cancel reminder period (see, Knorr ¶ 20). Relying on the foregoing, the Examiner's Answer alleges that Knorr teaches notifying a user that they can add at least the first article to the pending order without delaying the pending order shipment. However, while Knorr mentions a last chance to change or cancel reminder period, Knorr fails to disclose that a reminder is to be sent to the purchaser informing the purchaser that an item can be added to the pending order within a first amount of time without delaying the shipment date of the pending order. Further, it is not inherent in Knorr that the reminder associated with the last chance to change or cancel reminder period informs the purchaser that an item can be added to the pending order within a first amount of time without delaying the shipment date of the pending order. For example, the period may relate to internal policies of the vendor rather than any shipping date.

Thus, Knorr further fails to expressly or inherently disclose "a third module that causes a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment," as

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recited by Claim 1, or "providing a notification for the user that indicates that the user can add the first article to the pending order without delaying the pending order shipment date," as recited by Claim 50.

C.

In addition, the Examiner's Answer alleges that Knorr is structurally capable of performing the second and third identification and notification as claimed, alleging, at pages 12-13 of the Examiner's Answer, that "the structural system of Knorr is capable of identifying at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order and notifying a user that they can add at least the first article to the pending order without delaying the pending order shipment, therefore it meets the limitations of the claim." Appellant respectfully notes that the pending claims do not refer to a second and third identification. Appellant assumes that the Examiner's Answer is referring to the second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order, and the third module that causes a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment, as recited by Claim 1.

However, as similarly discussed above, Knorr is not capable of identifying at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order, and is further not capable of notifying a user that they can add at least the first article to the pending order without delaying the pending order shipment. Knorr is therefore not structurally capable of performing the functions of the second and third modules.

D.

Claims 10 and 59

In the Appeal Brief, Appellant argued that the rejection of Claims 10 and 59 is improper in view of the respective dependencies from Claims 1 and 50.   Appellant further argued that while Knorr refers to a pending order database and to suggestive selling, Knorr does not expressly or inherently disclose that the suggestive selling of Knorr involves identifying an

article that can be added to the pending order based in part on user history order information retrieved from a database.

In responding to the foregoing arguments, the Examiner's Answer (Examiner's Answer, Section D, at pages 13-14) relies on paragraph 65 of Knorr, alleging that the pending order in Knorr is stored in the database and the system of Knorr uses this stored information to suggest items for cross-selling. Appellant notes that while paragraph 65 of Knorr discloses "the administrator of the order pending database may implement a system to aid in logistics assurance ... the order pending database owner may implement a system by which, in conjunction with product availability confirmation messages as described herein, the order pending database owner can provide for notification of product upgrades or new models or versions, to a purchaser during the period in which a transaction is pending," no mention is made of using the order pending database for cross-selling.

Thus, while paragraph 65 discloses that an order pending database holds the information for the order pending shopping cart for an event, the only mention of cross-selling is the following: "As indicated in the electronic vendor path at 546, the vendor can use the time between the electronic hold and the ultimate order execution to plan inventory and interact with the purchaser for suggestive sellings, i.e., up-selling and or cross-selling." The foregoing citation makes no mention as to how cross-selling is accomplished, and no further mention is made by Knorr of cross-selling.

Thus, Knorr fails to expressly or inherently disclose "wherein the first article is identified based in part on user history order information retrieved from the database," as recited by Claim 10, or "wherein the first article is identified based in part on user history order information retrieved from the database," as recited by Claim 59.

Claims 12 and 61

In the Appeal Brief, Appellant argued that the rejection of Claims 12 and 61 is improper in view of their respective dependencies from Claims 1 and 50. Appellant further argued that while Knorr refers to a recipient profile, Knorr makes no mention of identifying an article based on user preference information retrieved from a database.

In responding to the foregoing arguments, the Examiner's Answer (Section D, at pages 14-15) cites paragraph 42 of Knorr, as follows:

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In some methods, the event profile data elements are obtained directly from the recipient or the purchaser, for example, by keying into the order pending application. In some situations, a third-party database, such as a PDA database or electronic address book can be the electronic source of the event information ... For example, a purchaser or potential purchaser may be presented with an array of events entered in their scheduler for which they may wish to pend an order with the order pending database. Based on this body of events, periodic reminders of events for which no order is pended may be presented to the purchaser to suggest pending an order, or even suggesting suitable items pertinent to widely-recognized events such as holidays, perhaps with regard to certain individuals from the purchaser's personal individual contacts database.

The Examiner's Answer alleges that the foregoing citation "plainly teaches identifying an article that can be added to the pending order based in part on preference information of a user placing an order wherein the preference information is retrieved from a database."

However, the Examiner's Answer has mischaracterized Knorr. The foregoing citation at paragraph 42 of Knorr is directed to identifying events and individuals from a database, and to suggesting suitable items pertinent to widely-recognized events such as holidays. However, the "suitable items" of Knorr are not identified based on user preference information. Instead, the "suitable items" are generically suggested because the items are pertinent to widely-recognized events such as holidays.

Thus, Knorr fails to expressly or inherently disclose "wherein the first article is identified based in part on user preference information retrieved from the database," as recited by Claim 12, or "wherein the first article is identified based in part on user preference information retrieved from the database," as recited by Claim 61.

Claims 4 and 53

Claims 4 and 53 are rejected under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2003/0097311 to Shinohara et al. In the Appeal Brief, Appellant argued that the rejection of Claims 4 and 53 is improper in view of their respective dependencies from Claims 1 and 50. Appellant further noted that, in rejecting Claims 4 and 53, the Final Office Action admits that Knorr fails to disclose wherein the notification is provided via an email transmitted to a user email address, but alleges that Shinohara discloses the missing elements. Appellant also noted that the Final Office Action alleges that it "would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Shinohara to receive the status of an ordered item."

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However, Appellant argued that the notification referred to in Claims 4 and 53 is not providing the status of an ordered item as stated in the Final Office Action. Instead, the notification of Claims 4 and 53 indicates that a user can add at least the first article to a pending order without delaying the pending order shipment. Therefore, Appellant argued that even if the Knorr were combined with the teachings of Shinohara to receive the status of an ordered item as set forth in the Final Office Action, the result would still fail to provide a notification via email that indicates that a user can add at least the first article to a pending order. Instead, as indeed stated by the Final Office Action, the combination would provide the status of the ordered item.

In addition, Appellant argued in the Appeal Brief that because neither Knorr nor Shinohara disclose providing any type of notification that indicates that a user can add at least the first article to a pending order without delaying the pending order shipment, even if Knorr were modified with the email of Shinohara, the result would still fail to provide such an email notification that indicates that a user can add at least the first article to a pending order without delaying the pending order shipment.

Appellant further argued in the Appeal Brief that the Final Office Action fails to articulate a clear rational for modifying Knorr with the icon of Shinohara and fails to demonstrate or even allege that the results of the proposed modification would have been predictable to one of ordinary skill in the art.

In response to the foregoing arguments, the Examiner's Answer (Section D, at page 15) merely states that the fact that Appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. The Examiner's Answer fails to further advance the arguments made in the Final Office Action and fails to respond to the Appellant's arguments made in the Appeal Brief. Indeed, the Examiner's Answer fails to provide any rational supporting the assertion that the claimed features "would flow naturally from following the suggestion of the prior art" and so has failed to make a prima facie case of obviousness with respect to Claims 4 and 53.

Indeed, the references do not collectively suggest "wherein the notification is provided via an email transmitted to a user email address," as recited by Claim 4, or "wherein the

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apparatus is configured to provide the notification via an email transmitted to a user email address," as recited by Claim 53.

Claims 5 and 54

Claims 5 and 54 stand rejected under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2005/0010857 to Shmukler et al. In the Appeal Brief, Appellant argued that the rejection of Claims 5 and 54 is improper in view of the respective dependencies from Claims 1 and 50. Appellant further noted that, in rejecting Claims 5 and 54, the Final Office Action admits that Knorr fails to disclose wherein the notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired and alleges that Shmukler discloses the missing elements.

The Appeal Brief argued that the Final Office Action mischaracterized Shmukler, noting that while Shmukler discloses a link and a notification that an offer expired, Shmukler does not disclose that a notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired.

The Appeal Brief argued that, therefore, even if the link of Shmukler were combined with Knorr, the result would still not provide a message indicating that the first amount time to add articles to the pending order has expired, as neither Knorr nor Shmukler disclose a message indicating that the first amount time to add articles to the pending order has expired.

Further, the Appeal brief argued that the Final Office Action failed to articulate a clear rational for modifying Knorr with the icon of Shmukler, and instead improperly relies on a conclusory statement. For example, Appeal Brief noted that the Final Office Action fails to demonstrate or even allege that the results of the proposed modification would have been predictable to one of ordinary skill in the art.

In response to the foregoing arguments, the Examiner's Answer (Section D, at pages 15-16) alleges that Shmukler, at paragraphs 82 and 87, discloses a notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message

indicating that the first amount of time to add articles to the pending order has expired. Paragraphs 82 and 87 of Shmukler recite:

> When a user receives the newsletter and has an interest in one or more of the items described therein, the user may obtain additional information by clicking on the particular hyperlink. As an example, if the user were to click on the first hyperlink 802, he or she would be directed to additional information about this item in the form of another screen 900, i.e., an HTML document, as shown in FIG. 9. (¶82)
>
> If a user clicks on the "expired" link, he or she may be directed to an explanatory screen 1200, as shown in FIG. 12. A section 1202 then explains that the selected items is no longer available (¶ 87).

While Shmukler discloses that a newsletter includes a link which when clicked on indicates that selected items are no longer available, the foregoing citations fail to even mention a notification regarding adding articles to a pending order, much less including a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired.

Indeed, the references do not collectively suggest "the notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired," as recited by Claim 5 or "wherein the notification includes a link, wherein if the user activates the link after a first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired," as recited by Claim 54.

Claims 2, 7-8, 11, 51, 56-57 and 60

With respect to Claims 2 and 51, in the Appeal Brief Appellant argued that the Knorr and Martson, separately or in combination, fail to disclose providing any type of notification that indicates that a user can add at least the first article to a pending order without delaying the pending order shipment, and so that even if Knorr were modified with the icon of Martson, the result would still fail to provide such a notification as an icon displayed via a toolbar on a user terminal. Appellant argued that combining Martson with Knorr as proposed by the Final Office Action would instead merely result in alerting a user of a change in the system. Further, Appellant argued that the Final Office Action fails to articulate a clear rational for modifying Knorr with the icon of Martson, and instead improperly relies on a conclusory statement, without

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demonstrating or even alleging that the results of the proposed modification would have been predictable to one of ordinary skill in the art.

With respect to Claims 7 and 56, in the Appeal Brief Appellant argued that the Final Office Action has mischaracterized Silverbrook, noting that while Silverbrook discloses adding an item to a pending order, it appears that the item is added in Silverbrook during the same session as the pending order, rather than during a second network session. Appellant further argued that even if the system of Knorr were modified to include the teachings of Silverbrook, the result would still not enable a user to add an article that had been identified to the user as being addable to a pending order within a first amount of time without delaying the shipment date of the pending order. Appellant also argued that the Final Office Action has failed to articulate a clear rational for modifying Knorr with Silverbrook and instead improperly relies on a conclusory statement.

With respect to Claims 8 and 57, in the Appeal Brief Appellant argued that even if the system of Knorr were modified to include the teachings of the Final Office Action's alleged Office Notice (that using location information to determine transport time to an area is old and well known), the result would still not use the location information to identify at least a first article that can be added to a pending order within a first amount of time without delaying the shipment date of the pending order. Appellant also argued that the Final Office Action has failed to articulate a clear rational for modifying Knorr with Official Notice and instead improperly relies on a conclusory statement.

With respect to Claims 11 and 60, in the Appeal Brief Appellant argued that neither Knorr nor Official Notice (that identifying an article based on a quantity available in a shipping center is old and well known) are concerned with or even mention up-selling overstocked items, and so there would be no rational to modify the system of Knorr as proposed by the Final Office Action. Appellant further argued that even if the system of Knorr were modified to include the teachings of the Final Office Action's Official Notice, the result would still not use the quantity information to identify at least a first article that can be added to a pending order within a first amount of time without delaying the shipment date of the pending order. Appellant also argued that the Final Office Action has failed to articulate a clear rational for modifying Knorr with Official Notice and instead improperly relies on a conclusory statement.

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The Examiner's Answer fails to substantively discuss the arguments presented in the Appeal Brief with respect to Claims 2, 7-8, 11, 51, 56-57 and 60, instead merely alleges that the arguments in the Appeal Brief are conclusory (Section D, at page 16). In view of the discussion above and in the Appeal Brief, it is clear that Appellant has not made conclusory arguments with respect to the rejections of Claims 2, 7-8, 11, 51, 56-57 and 60, and has instead noted features specifically lacking in the combination of references relied upon by the Final Office Action. Thus, Appellant has provided supporting evidence as to why the combinations are insufficient.

In failing to substantively address Appellant's arguments, the Examiner's Answer fails to explain how the references collectively teach or suggest the claim features of Claims 2, 7-8, 11, 51, 56-57 and 60 at issue. Thus, the Examiner's Answer is not fully responsive to Appellant's arguments.

CONCLUSION

For the reasons explained above and in the Appeal Brief, the rejections of claims 1-13 and 50-62 are improper and should be reversed.

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Dated: November 3, 2009

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